



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|-----------------------------|
| 09/330,056 | 06/11/1999 | KOHJI TAKAHARA | 0557-4696-2 | 8925 |
| 22850 7590 10/12/2007 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | EXAMINER PAULA, CESAR B | |
| | | | ART UNIT 2178 | PAPER NUMBER |
| | | | NOTIFICATION DATE 10/12/2007 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

09/330,056

Applicant(s)

TAKAHARA, KOHJI

Examiner

CESAR B. PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 8-10, 15-17 and 22-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-10, 15-17, AND 22-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the RCE amendment filed on 7/30/2007.

This action is made Non-Final.

2. In the amendment, claims 1-3, 8-10, 15-17, and 22-42 are pending in the case. Claims, 1, 8, 15, 22, 25, 28, 31, 33, 35, 37, 39, and 41 are independent claims.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # 10-179,731 filed in Japan on 6/11/1998, which papers have been placed of record in the file.

Drawings

4. The formal drawings filed on 9/20/02 have been approved by the draftsman.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2178

6. Claims 1-3, 8-10, 15-17, and 22-42 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Lesnick et al, hereinafter Lesnick (Pat.# 4,760,606, 7/26/1988), in view of Gillings et al, hereinafter Gillings (Pat.# 5,666,490, 9/9/1997), and further in view of Microsoft "Getting Results with Microsoft Office 97", 1997; pp.376-381.

Regarding independent claim 1, Lesnick discloses a network of user client workstations linked together in a computer local area network, to a central computer server with a main data storage. The server is directly connected via a data link means—*cable--* (col.3, lines 32-67, col. 4, lines 10-67, fig.2-3).

Moreover, Lesnick discloses a main data storage for storing digitized document images, which are classified into file or folders in accordance to the user information stored in a header page (col. 4, lines 4-67, and col. 11, lines 11-67).

In addition, Lesnick discloses a scanner document processor for feeding, digitizing, and classifying directly into a computer server—*storing server--*, documents based upon the information detected in header pages, which are separate from the document pages (col.3, lines 31-col. 4, line 67, and col. 10, lines 53-col. 11, line 67). Every time a new header page is encountered, a new file for storing document image data is created by an image library (col. 11, lines 10-36). For example, if there is a first header page—*format image data--* followed by corresponding document pages, and after these document pages there is a second header page with its respective document pages, then whenever the first header page is encountered—*first sheet of format image data is detected--* its document pages are scanned and stored in a first file. Once the first header page and its corresponding document pages have been processed, the

Art Unit: 2178

second header page—format image data-- is then accessed—second sheet of format image data is detected-- which effectively indicates the end of the documents belonging to the first header page. This in turn triggers the creation of a second file for storing the document pages associated with the second header page.

Further, Lesnick discloses the automatic—*not through users--* digitization of documents, and header pages—*sheet document image data, and sheet of format image data--* to be input into a main data storage for storing digitized document images, which are classified into *file folders*. The document images are sent to an OCR device (using or designating a single file name for those images in the file) for performing character recognition of the image (col. 3, lines 37-col. 4, line 67, and col. 11, lines 11-67). Lesnick fails to explicitly disclose *an image information storing server connected to the network and configured to store (1) registered group names and corresponding user names for each respective group name in a group name table and (2) image information in various folders to be read by the plurality of users; retrieving the group name table*. However, Office teaches creating a personal distribution list—*group name table registered in the name table--* containing the names of everyone in a distribution group (page 380). It would have been obvious to a person of ordinary skill in the art at the time of the invention to allow users to access the information stored in the folders, and storing the documents sent to each user described in the list, because this would enable the users to interact with the main data storage, and retrieve image information pertaining to such individual uses according to the information included in the header pages, and for all the reasons found in Office, including making it easy to send documents to users in a certain group of people (page 380).

Art Unit: 2178

Furthermore, Lesnick fails to explicitly disclose *the format image information indicates a user name; a group name previously registered in the group name table, a controller determines if the group name is registered by retrieving the group name table, and if the group name is registered in the group name table, the image information server stores the sheet document image information in an applicable folder of each registered user corresponding to the group name.* However, Gillings teaches distributing documents based on workgroup names used to index the documents (col.6, line 46-col.7, line 16). Office teaches creating a personal distribution list, containing the names of everyone in a distribution group (page 380). It would have been obvious to a person of ordinary skill in the art at the time of the invention to use group names in the barcode taught by Lesnick, together with the teachings of Gillings, and Office, because Gillings teaches overcoming the inefficiency of letting only one user at a time to access case reports (col.1, lines52-col.2, line3), and for all the reasons found in Office, including making it easy to send documents to users in a certain group of people (page 380).

Regarding claim 2, which depends on claim 1, Lesnick teaches a header page describing user associated with a document page(s) to be digitized (col. 4, lines 32-67, fig. 6).

Regarding claim 3, which depends on claim 1, Lesnick discloses the storage of the document pages as a single document in a document file (col. 11, lines 10-44).

Claims 8-10 are directed towards a computer system for implementing the system found in claims 1-3, and therefore are similarly rejected.

Claims 15-17 are directed towards a method for implementing the system found in claims 1-3 respectively, and therefore are similarly rejected.

Regarding independent claim 22, the limitations: *A network system including a plurality of users connected through a plurality of client terminal devices connected to a network....wherein the sheet of format image data is detected with sheet document image data....* are directed to the limitations found in claim 1, and therefore are similarly rejected.

Further, Lesnick discloses a header page with a “user identification number” for the classification and storage of processed documents. The processed documents are stored within files in accordance with the header sheet (col. 4, lines 47-50, col. 11, lines 10-36). Lesnick fails to explicitly disclose *the sheet of format image data indicates a group name...stores the sheet document image data in applicable folders defined by the group user name*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to group the document image information in folders defined by group user name, because Lesnick teaches above, the classification of documents having the same user id. This would provide the benefit of grouping documents according the user id—*group user name*.

Furthermore, Lesnick fails to explicitly disclose *the format image data indicates a user name; a group name, a controller determines if the group name is registered, and if the group name is registered, the image information server stores the sheet document image data in an applicable folder of each registered user corresponding to the group name; the format image data indicates a user name*. However, Gillings teaches distributing documents based on

Art Unit: 2178

workgroup names used to index the documents (col.6, line 46-col.7, line 16). Office teaches creating a personal distribution list, containing the names of everyone in a distribution group (page 380). It would have been obvious to a person of ordinary skill in the art at the time of the invention to use group names in the barcode taught by Lesnick, together with the teachings of Gillings, and Office, because Gillings teaches overcoming the inefficiency of letting only one user at a time to access case reports (col.1, lines52-col.2, line3), and for all the reasons found in Office, including making it easy to send documents to users in a certain group of people (page 380).

Claim 23 is directed towards a network system equivalent to the system found in claim 22, and therefore is similarly rejected.

Regarding claim 24, which depends on claim 22, Lesnick discloses the storing digitized document images as a single file bitmap representation, and then stored into a file folder (col. 11, lines 11, lines 11-67).

Claims 25-27 are directed towards a network system equivalent to the system found in claims 22, 22, and 24 respectively, and therefore are similarly rejected.

Claims 28-30 are directed towards a method for controlling a network system equivalent to the system found in claims 22, 22, and 24 respectively, and therefore are similarly rejected.

Art Unit: 2178

Claim 31 is directed towards a network system equivalent to the system found in claim 1, except for *wherein when the first sheet of format image data indicates a group name previously registered in the group name table, the image information server stores the sheet document image data in an applicable folder or file of the group name*, which is taught by Gillings teaches distributing documents based on workgroup names used to index the documents (col.6, line 46-col.7, line 16). Office teaches creating a personal distribution list—*group name table registered in the name table*-- containing the names of everyone in a distribution group (page 380). It would have been obvious to a person of ordinary skill in the art at the time of the invention to use group names in the barcode taught by Lesnick, and the distribution list taught by Office, because Gillings teaches overcoming the inefficiency of letting only one user at a time to access case reports (col.1, lines52-col.2, line3), and for all the reasons found in Office, including making it easy to send documents to users in a certain group of people (page 380), and therefore are similarly rejected.

Claims 32-37 are directed towards a network system equivalent to the system found in claims 3, 31, 3, 31, 3, and 1 respectively, and therefore are similarly rejected.

Claims 38-42 are directed towards a network system equivalent to the system found in claims 3, 1, 3, 1, and 3 respectively, and therefore are similarly rejected.

Response to Arguments

7. Applicant's arguments filed 7/30/2007 have been fully considered but they are not persuasive. The Applicant states that Lesnick does not teach a scanner with a document feeder connected to the server, not through the users (pages 18, last para.-20). The Examiner disagrees, since Lesnick discloses the automatic—*not through users*-- digitization of documents, and header pages—*sheet document image data, and sheet of format image data*-- to be input into a main data storage for storing digitized document images, which are classified into *file folders*. The document images are sent to an OCR device (using or designating a single file name for those images in the file) for performing character recognition of the image (col. 3, lines 37-col. 4, line 67, and col. 11, lines 11-67). The users are not involved in the scanning of the documents. It is not through the users that the scanning is performed.

Moreover, the Applicant submits that “that is: in the claims a determination is made as to whether a specific document includes a group name previously registered in a group name table, and if the group name is registered by retrieving the group name table. The Microsoft Office has no even similar operation”, parag.20, parag.2). Gillings teaches distributing documents based on workgroup names used to index the documents (col.6, line 46-col.7, line 16). Office teaches creating a personal distribution list, containing the names of everyone in a distribution group (page 380). It would have been obvious to a person of ordinary skill in the art at the time of the invention to use group names in the barcode taught by Lesnick, together with the teachings of retrieving the workgroup names as taught by Gillings, and group name table storing the names as taught by Office, because Gillings teaches overcoming the inefficiency of letting only one user at

Art Unit: 2178

a time to access case reports (col.1, lines52-col.2, line3), and for all the reasons found in Office, including making it easy to send documents to users in a certain group of people (page 380).

In response to applicant's argument that Office is nonanalogous art (page 21), it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Office discloses the use of a distribution list for distributing data to the members included in the list. It would have been obvious to a person of ordinary skill in the art at the time of the invention to use group name table storing the user names as taught by Office, for distributing the digitized documents to users found in the distribution list, because of all the reasons found in Office including making it easy to send, and target documents to users in a certain group of people (page 380).

Conclusion

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be

Art Unit: 2178


obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:
Commissioner for Patents
P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER
9/28/2007